IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : William N. Youstra   Art Unit : 2661
Serial No. : 09/867,797   Examiner : Avi M. Gold
Filed : May 31, 2001
Title : AUTHENTICATION OF ELECTRONIC DATA

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

BRIEF ON APPEAL

(1) Real Party in Interest

America Online, Inc., the assignee of this application, is the real party in interest.

(2) Related Appeals and Interferences

There are no related appeals or interferences.

(3) Status of Claims

Claims 1, 19, and 20 were rejected under 35 U.S.C. 102(e) as being anticipated by Movalli et al. (U.S. Patent No. 6,745,936) in a Final Office Action mailed December 15, 2004. Claims 1-3, 5-7, 9-15, 17, 19, 20, 22, 23, 25-27, 29-31, 33, 34, 36, 37, 40, 41, and 43 were rejected under 35 U.S.C. 103(a) as being obvious over Drummond et al. (U.S. Patent No. 6,691,156) in view of Movalli. A Notice of Appeal was filed April 15, 2005.

(4) Status of Amendments

Claims 1-45 are pending in this application, with claims 1, 19, 20, 25, 29, 33, 34, and 39 being independent. Claims 1-45 have not been amended after the final Office Action. Thus, all amendments have been entered. The claims are copied in Appendix A.

(5) Summary of Claimed Subject Matter

The subject matter of independent claims 1, 19, 20, 25, 29, 33, 34, and 39 relates to exchanging electronic data transmitted from a sender that has been addressed to an intended recipient. The electronic is modified with endorsement information. More precisely, a communications system host receives electronic data from a sender. See, e.g., Application,

page 17, ll. 21-25. The electronic data is addressed to an intended recipient. See, e.g., Id, page 17, ll. 26-31. The electronic data is endorsed based on attributes of the electronic data. See, e.g., Id. The electronic data then is modified with endorsement information. See, e.g., Id., page 18, ll. 13-15.

For example, an Internet Service Provider (ISP) may operate a host that is configured to exchange messages on behalf of ISP subscribers. See, e.g., Id., pages 17, ll. 21-25. In such a system, an ISP system administrator may desire to contact an ISP subscriber with sensitive information, such as information related to suspicious activity. See, e.g., Id., pages 18, ll. 1-6. One challenge in operating such a system is that a malicious user may attempt to impersonate the ISP system administrator. See, e.g., Id. To combat this and other challenges, an ISP system administrator may send a message to the host. See, e.g., Id. The host receives the message from the ISP system administrator. See, e.g., Id., pages 18, ll. 1-6. The message is endorsed based on attributes of the message (e.g., sensitive messages to ISP subscribers may only be sent by certain employees), and modified with endorsement information. See, e.g., Id., page 17, ll. 26-31 (electronic data is endorsed based on attributes of electronic data). In one implementation, a reserved header in a sensitive electronic mail message may be modified to reflect message status as a sensitive messages from a ISP system administrator. See, e.g., Id., page 19, ll. 4-10 and Figs. 8-9B (electronic mail message is rendered as distinguishable icon in the inbox as shown in Fig. 8 and/or uses a distinguishable chrome in the border as shown in Fig. 9A as Official AOL Mail).

Claims 19 and 20 recite a system and computer program residing on a computer readable medium, respectively, configured to perform the operations described above. See, e.g., Id., page 3, l. 22-page 4, l. 7. Claim 25 recites operations that may be performed as a result of receiving, from a communications system host, endorsement information indicating that the electronic data has been endorsed. See, e.g., Id., page 18, l. 29-page 19, l. 10. The information is rendered so as to inform the user that the electronic data has been endorsed. See, e.g., Id., Figs. 8 and 9B. Claims 33 and 34 recite a system and computer program residing on a computer readable medium, respectively, configured to perform the operations as a result of result of receiving, from a communications system host, endorsement information indicating that the electronic data has been endorsed. See, e.g., Id.

(6)   Issues

(1) Is the subject matter of claims 1, 19, and 20 anticipated by Movalli?

(2) Is the subject matter of claims 1-3, 5-7, 9-15, 17, 19, 20, 22, 23, 25-27, 29-31, 33, 34, 36, 37, 40, 41, and 43 rendered obvious by Drummond in view of Movalli?

(3) Is the subject matter of claims 14, 15, 26, 27, 40, and 41 rendered obvious by Drummond in view of Movalli?

(7)   Grouping of Claims

The claims do not stand or fall together. However, for the purpose of this appeal, the arguments are organized into three sections. First, claims 1, 19, and 20 are not anticipated by Movalli. Second, claims 1-3, 5-7, 9-15, 17, 19, 20, 22, 23, 25-27, 29-31, 33, 34, 36, 37, 40, 41, and 43 are not rendered obvious by Drummond in view of Movalli. Third, claims 14, 15, 26, 27, 40, and 41 are not rendered obvious by Drummond in view of Movalli.

(8)   Argument

The subject matter of claims 1, 19, and 20 is not anticipated by Movalli.

Claims 1, 19, and 20 have been rejected as being anticipated by U.S. Patent No. 6,745,936 to Movalli et al., referenced hereinafter as Movalli. For the reasons set forth below, reversal of the rejection of claims 1, 19, and 20 is requested.

Claim 1 recites a method for transmitting electronic data by receiving, at a communications system host, electronic data transmitted from a sender and addressed to an intended recipient. The electronic data is modified with endorsement information, and thus is endorsed based on attributes of the electronic data. Movalli fails to describe or suggest such features.

The final Office Action states that these limitations are disclosed by Movalli. Specifically, the final Office Action references Col. 3, ll. 31-39 of Movalli to teach "receiving, at a communications system host, electronic data transmitted from a sender and addressed to an intended recipient". Applicant disagrees, and submits that Movalli fails to teach "receiving, at a communications system host, electronic data transmitted from a sender and addressed to an intended recipient", pointing out that Movalli is directed to a dramatically different system.

As indicated by the title, Movalli is directed to generating secured endorsed transactions. In particular, Movalli is directed to a system that batch processes transactions in a point-of-sale system. See Col. 7, ll. 63-Col. 8, ll. 9; see also Col. 7, ll. 25-37 (describing how credit card transactions are structured). As such, Movalli involves credit cart transaction data. While credit card transaction data is descriptive of a transaction, credit card transaction data is not addressed to an intended recipient. Movalli fails to receive any electronic data that has been transmitted from a sender to an intended recipient to whom that data is addressed. As such, Movalli fails to disclose "receiving, at a communications system host, electronic data transmitted from a sender and addressed to an intended recipient".

Because Movalli fails to disclose or suggest receiving, at a communications system host, electronic data transmitted from a sender and addressed to an intended recipient, as recited by claim 1, Applicant respectfully requests withdrawal of the rejection of claim 1 and dependent claims 2-18 and 40-45 depending therefrom. Claims 19 and 20 recite limitations that are similar to those discussed above for the purpose of the rejection raised with respect to claim 1. Accordingly, Applicant respectfully requests withdrawal of the rejection of independent claims 19 and 20 and their respective dependent claims (i.e., claims 21-24).

The subject matter of claims 1-3, 5-7, 9-15, 17, 19, 20, 22, 23, 25-27, 29-31, 33, 34, 36, 37, 40, 41, and 43 is not rendered obvious by Drummond in view of Movalli.

Claims 1-3, 5-7, 9-15, 17, 19, 20, 22, 23, 25-27, 29-31, 33, 34, 36, 37, 40, 41, and 43 have been rejected as being rendered obvious by a proposed combination of U.S. Patent No. 6,691,156 to Drummond and Movalli.

The final Office Action states that Drummond teaches "receiving, at a communications system host, electronic data transmitted from a sender and addressed to an intended recipient" on Col. 2, ll. 23-36, and "endorsing the electronic data based on attributes of the electronic data" on Col. 2, 37-56. Recognizing that Drummond's spam filtering system is fundamentally different than what is recited in claim 1, the final Office Action notes that Drummond fails to teach "modifying the electronic data with endorsement information" and instead turns to Movalli's purported disclosure of this limitation to teach the limitations recited in claim 1. See final Office Action page 3.

Applicant disagrees, and submits that the combination of Drummond and Movalli fails to render claim 1 obvious. Drummond is directed to a spam filtering system. In particular, Drummond blocks email messages from senders that do not appear in a user's address book. As such, Drummond merely allows a message meeting the address book criteria to be processed as an electronic mail message. Mere disclosure by Drummond of a system capable of processing an electronic mail message does not constitute disclosure of a system for modifying the electronic data with endorsement information. Thus, the proposed combination of Drummond is devoid of any disclosure of "endorsing the electronic data based on attributes of the electronic data".

Furthermore, there is no motivation to combine the teachings of Drummond with Movalli. Obviousness cannot be established simply by stitching together pieces of prior art using the patent as a template. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143 (Fed. Cir. 1985); see also Loctite Corp. v. Ultraseal Ltd., 781 F.2d 861, 873 (Fed. Cir. 1985) (denouncing courts' tendency to depart from proper standard of nonobviousness "to the tempting but forbidden zone of hindsight."); In re Fine, 837 F.2d 1071, 1075 (Fed. Cir. 1988) ("One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."); In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."). The cited references must provide some suggestion, motivation, or teaching for combining known components. See Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc., 21 F.3d 1068, 1072, 30 USPQ2d 1377, 1379 (Fed.Cir.1994) ("When the patented invention is made by combining known components to achieve a new system, the prior art must provide a suggestion or motivation to make such a combination."); C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340 (Fed. Cir. 2000).

The Examiner states that the combination would be motivated to allow "the recipient to easily know that the electronic data is sent from the source that it claims be from". See final Office Action at p. 4. However, neither Drummond nor Movalli would have led a person of ordinary skill in the art to modify Drummond in a way that would have resulted in the claimed system. Drummond is directed to a system that filters email at a mail gateway in

deciding whether to deliver a message. Movalli packages and inspects credit card transactions before transferring financial resources. Accordingly, a person of ordinary skill in the art would not have turned to Movalli for purposes of modifying Drummond, because both systems are directed to performing dramatically different goals using completely different operations: Drummond is a "spam filter" and Movalli is a "credit card processor." Moreover, the Drummond and Movalli teachings are directed to entirely different fields of endeavor, one to credit card processing and the other to email spam fighting with each being directed to different technologies for purposes of solving completely different technical problems. As a result, a person of ordinary skill in the art would not have found specific motivation in either Drummond or Movalli to combine the systems.

Accordingly, the requisite motivation to combine the references has not been provided. Thus, the Examiner has not presented a *prima facie* case of obviousness.

Because there is no motivation to combine Drummond with Movalli, Applicants respectfully request reconsideration and withdrawal of rejections of claims 1-3, 5-7, 9-15, 17, 19, 20, 22, 23, 25-27, 29-31, 33, 34, 36, 37, 40, 41, and 43.

The subject matter of claims 14, 15, 26, 27, 40 and 41 are not rendered obvious over the combination of Movalli and Drummond.

Claims 14, 15, 26, 27, 40, and 41 have been rejected as being rendered obvious by Drummond and Movalli. In fact, the final Office Action states that the limitations added by claims 14, 15, 26, 27, 40 and 41 are disclosed in Drummond. In addition to being allowable by virtue of their dependence from independent claims 1 and 25, which are allowable for the reasons articulated above, the following argument provides yet another grounds for allowability.

Both claims 14 and 15 depend from claim 11, which recites "presenting the endorsement information to the intended recipient." Claim 14 recites that "the endorsed information is capable of being rendered by the intended recipient as an icon indicative of endorsement." Claim 15 recites that "the endorsed information is capable of being rendered by the intended recipient as a graphical user interface indicative of endorsement."

The final Office Action states that these limitations are disclosed in Col. 2, ll. 37-56. See final Office Action pages 6 and 7. However, Applicant disagrees and submits that the

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cited portion of Drummond fails to disclose (1) "the endorsed information is capable of being rendered by the intended recipient as an icon indicative of endorsement" as recited by claim 14; or (2) "the endorsed information is capable of being rendered by the intended recipient as a graphical user interface indicative of endorsement" as recited by claim 15. The cited portion of Drummond appears below.

> According to a preferred embodiment, a list of approved addresses is maintained at the e-mail server for each user, preferably without requiring the user's interaction. The address of any outbound e-mail sent from an e-mail client is automatically added to the user's approved address list. An inbound e-mail having a sending address that is seen for the first time is delivered to a holding queue instead of being delivered to the intended recipient. The server responds to the inbound e-mail by issuing an e-mail back to the unknown sending address, requesting a return acknowledgement. If the acknowledgement is received within a given time period, the e-mail is released from the holding queue and delivered to the intended recipient. If, however, an acknowledgement is not received within the given time period, it is flushed from the holding queue. Using this method, spam e-mail accumulates in the user's holding queue instead of being delivered to the user's inbox because spamming is typically accomplished by automated routines that cannot or do not respond to the e-mail's server's request for acknowledgement.

As shown above, Drummond only references the routine delivery of email into an inbox. Drummond does not distinguish between endorsed messages and nonendorsed messages as the endorsed messages are presented to the user. The significance of this distinction may be profound in a variety of contexts. For example, insofar as Applicant's system may be configured to combat fraudulent imposters posing as system administrators, the features recited in claims 14 and 15 may be used to provide a visual indication that a sensitive message has been endorsed by an ISP administrator, and thus, can be relied upon.

There is a complete failure in Drummond to describe or suggest any functionality related to the limitations recited in claims 14 and 15, either in the cited portion or elsewhere.

Accordingly, because Drummond and Movalli fail to disclose or suggest "the endorsed information is capable of being rendered by the intended recipient as an icon indicative of endorsement" and "the endorsed information is capable of being rendered by the intended recipient as a graphical user interface indicative of endorsement", as recited by claims 14, 15, 26, 27, 40, and 41, Applicant respectfully requests withdrawal of the rejection of these claims.

Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: 9/15/200 _____

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Appendix of Claims

1. A method for transmitting electronic data, the method comprising:

receiving, at a communications system host, electronic data transmitted from a sender and addressed to an intended recipient;

endorsing the electronic data based on attributes of the electronic data; and

modifying the electronic data with endorsement information.

2. The method of claim 1 wherein endorsing comprises identifying the sender of the electronic data.

3. The method of claim 2 wherein the sender is identified by a screen name.

4. The method of claim 2 wherein the sender is identified by an IP address.

5. The method of claim 1 wherein endorsing further comprises designating a level of security corresponding to the sender of the electronic data.

6. The method of claim 1 wherein endorsing further comprises verifying that at least one attribute of the electronic data is an attribute of an authorized sender.

7. The method of claim 2 wherein the attribute comprises a screen name.

8. The method of claim 2 wherein the attribute comprises an IP address.

9. The method of claim 1 wherein endorsing further comprises designating a level of security corresponding to at least one attribute of the electronic data.

10. The method of claim 1 further comprising:
storing content of the electronic data in a first storage area of the communications system host; and

storing attributes of the electronic data in a second storage area of the communications system host.

11. The method of claim 1 further comprising presenting the endorsement information to the intended recipient.

12. The method of claim 1 wherein the endorsed information is presented with the attributes of the electronic data.

13. The method of claim 11 wherein the endorsed information is presented with the content of the electronic data.

14. The method of claim 11 wherein the endorsed-information is capable of being rendered by the intended recipient as an icon indicative of endorsement.

15. The method of claim 11 wherein the endorsed information is capable of being rendered by the intended recipient as a graphical user interface indicative of endorsement.

16. The method of claim 15 wherein the graphical user interface includes a border indicative of endorsement around contents of the electronic data.

17. The method of claim 1 wherein the electronic data comprises an e-mail message.

18. The method of claim 1 wherein the electronic data comprises an instant message.

19. An apparatus for transmitting electronic data, the apparatus comprising a host configured to:

receive, at a communications system host, electronic data transmitted from a sender and addressed to an intended recipient;

endorse the electronic data based on attributes of the electronic data; and

modify the electronic data with endorsement information.

20. A computer program, stored on a computer readable medium, comprising instructions for:

receiving, at a communications system host, electronic data transmitted from a sender and addressed to an intended recipient;

endorsing the electronic data based on attributes of the electronic data; and

modifying the electronic data with endorsement information.

21. The computer program of claim 20 wherein the computer readable medium is a disc.

22. The computer program of claim 20 wherein the computer readable medium is a client device.

23. The computer program of claim 20 wherein the computer readable medium is a host device.

24. The computer program of claim 20 wherein the computer readable medium is a propagated signal.

25. A method for receiving electronic data transmitted from a sender to an intended recipient through a communications system, the communications system endorsing the electronic data based on attributes of the electronic data, the method comprising:

receiving, from a communications system host, information indicating that the electronic data has been endorsed; and

rendering the information to a user of the intended recipient so as to inform the user of the intended recipient that the electronic data has been endorsed.

26. The method of claim 25 wherein the endorsement information is rendered by the intended recipient as an icon indicative of endorsement.

27. The method of claim 25 wherein the endorsement information is rendered by the intended recipient as a graphical user interface indicative of endorsement.

28. The method of claim 27 wherein the graphical user interface includes a border indicative of endorsement around contents of the electronic data.

29. The method of claim 25 wherein the endorsement information is rendered with contents of the electronic data.

30. The method of claim 25 wherein the endorsed information is rendered with attributes of the electronic data.

31. The method of claim 25 wherein the electronic data comprises an e-mail message.

32. The method of claim 25 wherein the electronic data comprises an instant message.

33. An apparatus for receiving electronic data transmitted from a sender to an intended recipient through a communications system, the communications system endorsing the electronic data based on attributes of the electronic data, the apparatus comprising a client configured to:

receive, from a communications system host, endorsement information indicating that the electronic data has been endorsed; and

render the endorsement information to a user of the intended recipient so as to inform the user of the intended recipient that the electronic data has been endorsed.

34. A computer program stored on a computer-readable medium for receiving electronic data transmitted from a sender to an intended recipient through a communications system, the

communications system endorsing the electronic data based on attributes of electronic data, the computer program comprising instructions for:

receiving, from a communications system host, endorsement information indicating that the electronic data has been endorsed; and

rendering the information to a user of the intended recipient so as to inform the user of the intended recipient that the electronic data has been endorsed.

35. The computer program of claim 34, wherein the computer readable medium is a disc.

36. The computer program of claim 34, wherein the computer readable medium is a client device.

37. The computer program of claim 34, wherein the computer readable medium is a host device.

38. The computer program of claim 34, wherein the computer readable medium is a propagated signal.

39. A graphical user interface for rendering information associated with electronic data transmitted from a sender to an intended recipient, the graphical user interface rendering the endorsement information to a user of the intended recipient so as to inform the user of the intended recipient that the electronic data has been endorsed, the graphical user interface comprising a border indicative of endorsement around contents of the electronic data.

40. The method of claim 1 wherein appending the endorsement information enables a messaging application to visually distinguish endorsed messages from nonendorsed messages.

41. The method of claim 40 wherein enabling the messaging application to visually distinguish between endorsed and nonendorsed messages includes presenting an endorsed icon

for an endorsed electronic mail message in an electronic mail inbox that also includes nonendorsed electronic mail messages.

42. The method of claim 40 wherein enabling the messaging application to visually distinguish between endorsed and nonendorsed messages includes presenting an endorsed envelope, an endorsed seal, or an endorsed border for an endorsed electronic mail message that is differentiated from other envelopes, seals, or borders used in nonendorsed electronic mail messages.

43. The method of claim 1 wherein modifying the electronic data includes appending endorsement information to originally-received electronic data.

44. The method of claim 1 wherein modifying the electronic data includes instructing a rendering application that the electronic data represents endorsed communications.

45. The method of claim 1 wherein modifying the electronic data with endorsement information includes configuring a messaging communication to reflect endorsement by a messaging provider.

Evidence Appendix

No copies required

Related Proceedings Appendix

No copies required.